

### REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-27 are currently pending. Claims 1, 10, and 19 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,537,626 to Kraslavsky et al. (hereinafter “the ‘626 patent”) in view of U.S. Patent No. 5,416,842 to Aziz (hereinafter “the ‘842 patent”); and Claims 1-27 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-55 of U.S. Patent No. 6,889,263 to Motoyama (hereinafter “the ‘263 patent”).

Applicants wish to thank the Examiner for the interview granted Applicant’s representative on February 28, 2006, at which time a proposed amendment to the claims was discussed. In particular, transmission of status information using an Internet electronic mail protocol was discussed. However, no agreement was reached pending the Examiner’s further consideration of the claims upon formal submission of a response to the outstanding Office Action.

Amended Claim 1 is directed to a method of monitoring status of an office machine communitively coupled to a network, comprising: (1) transmitting status information of the office machine over the Internet using an Internet email protocol; (2) receiving the status information at a monitoring device; and (3) storing the status information in a database associated with the monitoring device, wherein the status information is stored in association with an identifier that uniquely identifies the office machine. Further, Claim 1 has been amended to clarify that the office machine is one of a printer, a copier, a scanner, a metering

system, and a vending machine. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.<sup>1</sup>

The '626 patent is directed to an apparatus for interfacing a printer with a local area network. As shown in Figure 1, the printer 4 includes a Network Expansion Board (NEB) 2 that is coupled to the LAN bus 6 through a LAN interface 8. Further, the '626 patent discloses that the NEB 2 is configured to export status and control information from the printer 4 to, for example, the PC 14 connected to the local area network. Further, as shown in Figure 2, the '626 patent discloses that the status of printer 78 may be obtained by a PC 42 over a wide area network. However, Applicant respectfully submits that the '626 patent fails to disclose transmitting status information of an office machine over the Internet using an Internet email protocol, as recited in amended Claim 1.

Further, Applicant respectfully submits that the network protocol disclosed by the '626 patent ("Netware") is not equivalent to an Internet protocol. In this regard, Applicant notes that the Board of Patent Appeals and Interferences appeal decision dated December 23, 2003, in related Application No. 08/738,659 ("the '659 application") states that:

[w]e find no disclosure or suggestion in Kraslavsky or Cohn, nor in any combination of the teachings thereof, for transmitting Internet electronic mail messages between machines, for monitoring device, as claimed by Appellant.<sup>2</sup>

Further, the Board's '659 decision also stated that "[w]e interpret transmission of the Internet electronic mail message, as claimed, as requiring more than the electronic message transmission as disclosed by Kraslavsky."<sup>3</sup> In addition, the Board stated that "however, we agree with Appellant, as developed in the briefs and the declaration, that the combination of Kraslavsky and Cohn would not have suggested the transmission of Internet electronic

<sup>1</sup> See, e.g., Figure 1 and the discussion related thereto in the specification.

<sup>2</sup> '659 Board decision dated December 23, 2005, page 5.

<sup>3</sup> Id. at page 4.

communications between a monitored and...a [monitoring] device as claimed.”<sup>4</sup> Moreover, Applicant notes that based on that Board’s decision, the independent claims in the ‘659 application were amended to recite transmitting the information through electronic mail...“using an Internet e-mail protocol,” and were thus subsequently allowed. Accordingly, Applicant respectfully submits that the ‘626 patent fails to disclose transmitting status information of an office machine over the Internet using an Internet protocol, as recited in Claim 1.

The ‘842 patent is directed to a method for sending data from one node to another node across a network that includes firewall servers. However, Applicant respectfully submits that the ‘842 patent fails to disclose the transmitting and receiving steps recited in amended Claim 1.

Thus, no matter how the teachings of the ‘626 and ‘842 patents are combined, the combination does not teach or suggest the step of transmitting status information of an office machine over the Internet using an Internet email protocol, as recited in Claim 1. Accordingly, Applicant respectfully submits that the rejection of Claim 1 (and dependent Claims 2-9) is rendered moot by the present amendment to Claim 1.

Independent Claims 10 and 19 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 10 and 19 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above of the patentability of Claim 1, Applicant respectfully submits that the rejections of Claims 10 and 19 (and all associated dependent claims) are rendered moot by the present amendment to Claims 10 and 19.

Applicant respectfully submits that the double patenting rejection of Claims 1-27 is rendered moot by the Terminal Disclaimer filed herewith.

---

<sup>4</sup> Id. at page 5.

Thus, it is respectfully submitted that independent Claims 1, 10, and 19 (and all associated dependent claims) patentably define over any proper combination of the '626 and '842 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

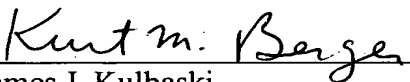
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000  
Fax: (703) 413-2220  
(OSMMN 06/04)

  
James J. Kulbaski  
Attorney of Record  
Registration No. 34,648  
Kurt M. Berger, Ph.D.  
Registration No. 51,461